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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
|-----------------|-------------|----------------------|---------------------|------------------|
| 09/997,578 | 11/29/2001 | James Kargman | 2011783 | 3750 |

34018 7590 09/02/2003

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EXAMINER

ROBINSON BOYCE, AKIBA K

| ART UNIT | PAPER NUMBER |
|----------|--------------|
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3623

DATE MAILED: 09/02/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/997,578

Applicant(s)

KARGMAN ET AL.

Examiner

Akiba K Robinson-Boyce

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 29 June 2003.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) ☐ The proposed drawing correction filed on _____ is: a) ☐ approved b) ☐ disapproved by the Examiner.
- If approved, corrected drawings are required in reply to this Office action.
- 12) ☒ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

- 13) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
- a) ☐ The translation of the foreign language provisional application has been received.
- 15) ☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

- 1) ☐ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____.
- 4) ☐ Interview Summary (PTO-413) Paper No(s). _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Status of Claims

1. Due to communications filed 6/29/03, the following is a final office action. Claims 1-32 are currently pending in this application and have been examined on the merits. Claim 9 has been amended and claim 32 has been added. The previous rejection has been withdrawn and the following rejection reflects the claims as amended.

Oath/Declaration

2. The oath or declaration is defective. A new oath or declaration in compliance with 37 CFR 1.67(a) identifying this application by application number and filing date is required. See MPEP §§ 602.01 and 602.02.

The oath or declaration is defective because:

Non-initialed and/or non-dated alterations have been made to the oath or declaration. See 37 CFR 1.52(c).

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

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4. Claims 1-14, 16-24 and 26-30, 32 are rejected under 35 U.S.C. 102(b) as being clearly anticipated by Cupps, et al (US Patent 5,991,739).

As per claims 1, 3, 7, 16, 18, 22, 26, 30, Cupps, et al discloses:

A method of receiving and placing an order on the Internet.../comprises using at least one of: The Internet..(Col. 2, lines 39-41):

storing at an Internet web site at least a partial list of stores.../storing said at least a partial list of stores.../storing a list of stores...(Col. 2, lines 39-50 and Col. 6, lines 19-30);

storing at said Internet web site a postal-service listing of customers...(Col. 5, lines 29-32);

creating the potentiality of establishing a point-to-point connection between the computer.../means for establishing communication with the computer...(Col. 12, lines 4-10);

receiving a request to order...(Col. 12, lines 23-25);

determining at said web site which store of said at least a partial list of stores services the customer...(Col. 12, lines 26-30);

receiving the order from the customer...(Col. 12, lines 65-66);

downloading the order received.../downloading a customer order...downloading the order directly into the computer system of the selected store...(Col. 13, lines 60-62).

a web-site on the Internet...(Col. 8, line 43-Col. 9, line 7).

As per claim 2, Cupps, et al discloses:

uploading from the computer of the selected store...the menu...(Col. 8, lines 43-55).

As per claims 4, 19, 27, Cupps, et al discloses:

storing said customer listing by street address...(Col. 5, lines 33-35).

As per claims 5, 6, 20, 21, 28, 29, Cupps, et al discloses:

comprises storing the service-map...comprising matching the street address of the customer.../comprises comparing the street address of the customer...with the street addresses of a plurality of chosen stores...(Col. 6, lines 39-56 and Col. 7, lines 22-23).

As per claims 8, 9, 32, Cupps, et al discloses:

comprises attempting to download the order first via one of the :
Internet.../comprises downloading the order directly into the computer system of the selected store via at least one of the : The Internet.../comprises uploading from the computer system of the selected store via at least one of the: The Internet...(Col. 12, lines 6-10, where the email communication and web communication allow downloading/uploading of data between the online ordering machine and the vendor [selected store]).

As per claim 10, Cupps, et al discloses:

uploading from the computer of the selected store...the estimated time of delivery...e-mailing the customer...(Col. 11, lines 20-27).

As per claims 11, 24, Cupps, et al discloses:

e-mailing the customer...a message that the selected store...cannot fill the order...(Col. 10, lines 44-56).

As per claim 12, Cupps, et al discloses:

uploading from at least one of the stores of said chain of stores the street-address servicing area...storing the street-address servicing area...(Col. 2, lines 45-48, Fig. 8).

As per claim 13, Cupps, et al discloses:

wherein said step of uploading from at least one of the stores of said chain of stores the street-address servicing area serviced by each said at least one store of said chain of stores....(Col. 6, lines 39-56, Col. 2, lines 45-48).

As per claim 14, Cupps, et al discloses:

wherein the order...is for at least one pizza...(Fig. 8).

The following is inherent with Cupps, et al's system because when ordering pizza, details such as size and toppings must be known in order to complete the order and satisfy the customer:

said customer selecting at least the size of the pizza and the toppings therefor.

As per claim 17, Cupps, et al discloses:

uploading from the computer of the selected store...the menu...(Col. 8, lines 43-55);

comprising storing a list of stores....(Col. 2, lines 39-50 and Col. 6, lines 19-30);

The following is inherent with Cupps, et al's system because when ordering pizza, details such as size and toppings are part of traditional order information:

comprising downloading the size of the pizza ordered...

As per claim 23, Cupps, et al discloses:

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placing an automated computer generated, voice-order...(Col. 2, line 62-Col. 3, line 6).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. Claims 15, 25 and 31 are rejected under 35 U.S.C. 103(a) as being unpatentable over Cupps, et al (US Patent 5,991,739).

As per claims 15, 25 and 31, Cupps, et al fails to teach the following:

Normalizing the address entered by the customer using address-normalization software...

Official notice is taken that it is old and well known in the delivery art to normalize addresses using address-normalization software. It would have been obvious to one of ordinary skill in the art to normalize addresses by using address-normalization software because this type of software is traditionally used in mail/delivery businesses to fulfill delivery compliance standards and to process deliveries faster and more efficiently.

Response to Arguments

7. Due to the amendment filed 6/29/03, the objection to claim 9 has been withdrawn.

8. Applicant's arguments filed 6/29/03 have been fully considered but they are not persuasive.

As per claims 1, 3, 7, 16, 18, 22, 26 and 30, the applicant's main argument is that the applicant's invention is patentably distinct from the disclosure of Cupps in that no human is required to answer an incoming telephone call or find and read an incoming facsimile to learn that a customer wishes to place an order and that the present invention allows the order to be downloaded directly into the computer system of the selected store. However, as acknowledged by the applicant, Cupps discloses that the invention is not constrained to transmitting a customer's order to the vendor through the interactive voice recognition system or fax system, but can be implemented through use of a modem connection, which will enable communication between the online ordering machine and the vendor through, for example web communications (See Col. 12, lines 4-10). This web communication would allow the user to skip the voice recognition/fax process and automatically download or upload information to and from the vendor's computer. In addition, when a customer submits an order request in Cupps, the order can be downloaded to the vendor's computer via the facsimile method. In this case, the order is downloaded directly to the vendor computer system via order *text file*. Note that the order text file is a file that is transmittable via computer. Here, the order text file is formatted and transmitted to the vendor via fax without relying solely on human

interaction. In modern technology, a facsimile system can be stored as an application on a computer's hard drive. Therefore, it is not uncommon for the order to be downloaded directly to the vendor's computer when using this fax method.

As per claims 2-14, 17-24 and 27-30, these claims depend from independent claims 1, 16 and 26 and are rejected for the same reasons as claims 1, 16 and 26.

As per claims 15, 25 and 31, these claims depend from independent claims 1, 16 and 26 and are rejected for the same reasons as claims 1, 16 and 26.

Conclusion

9. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Akiba K Robinson-Boyce whose telephone number is

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703-305-1340. The examiner can normally be reached on Monday-Friday, 8:30 am-5pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Tariq Hafiz can be reached on 703-305-9643. The fax phone numbers for the organization where this application or proceeding is assigned are 703-746-7238 [After final communications, labeled "Box AF"], 703-746-7239 [Official Communications], and 703-746-7150 [Informal/Draft Communications, labeled "PROPOSED" or "DRAFT"].

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-305-3900.



A. R. B.
August 28, 2003



TARIQ R. HAFIZ
SUPERVISORY P
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